REMARKS

Claims 1-38 are pending in this application. For purposes of expedition, claims 1, 3, 1, 1, 19, 20, 30 and 31 have been amended in several particulars for purposes of clarity and brevity that are unrelated to patentability and prior art rejections in accordance with current Office policy, to further and alternatively define Applicants' disclosed invention and to assist the Examiner to expedite compact prosecution of the instant application.

The drawings are objected to because FIG. 8 contains a line through the text of block 110. In response thereto, new drawing of FIG. 8 is enclosed to overcome the objection.

Claims 30 and 31 are objected to because "patterns" should be- - patterns--. In response thereto, claims 30 and 31 have been amended to overcome the objection.

Lastly, claims 1-38 are rejected under 35 U.S.C. §102(b) as being anticipated by Ito et al., U.S. Patent No. 5,881,032 for reasons stated on pages 3-6 of the Office Action. In support of the rejection of Applicants' base claims 1 and 12, the Examiner asserts that Ito '032 discloses an information storage medium comprising:

> "a user data area, wherein information about the user data are, where user data is recorded, is recorded in at least one of an area right before and an area right after a basic recording unit of the user data area ("the internal structure of each section is shown in FIG. 11; each sector thus comprises a header containing the address uniquely identifying the sector, a data block to which user data is recorded, and an error correction code (ECC) block to which is recorded a code used for error correction during reproduction" (col. 2, lines 6-11)).

However, the Examiner's assertion is factually incorrect. Applicants submit that key features of Applicants' base claims 1 and 12 are not disclosed or suggested by Ito '032. Therefore, Applicants respectfully request the Examiner to reconsider and withdraw this rejection for the following reasons.

Applicants' base claims 1 and 12 define an information storage medium having a user data area to record user data and a method of recording and reproducing user data in which information about the user data area, where user data is recorded, is recorded in [and read from] at least one of an area right before and an area right after a basic recording unit of the user data area. This way the information storage medium, i.e., an optical disk having one or more

recording layers, can advantageously be used as either a recordable storage medium (having groove wobbles) or a reproduction-only (read only) storage medium (having no groove wobbles); see paragraphs [0026], [0034], [0048] and [0049] of Applicants' specification.

Previously to Applicants' base claims 1 and 12, in recordable storage media, information about a user data area is recorded in groove wobbles because data may be randomly recorded or reproduced regardless of the sequence of physical addresses of basic recording units; see paragraph [0005] and FIG. 2 of Applicants' disclosure. In contrast to recordable storage media, reproduction-only (read only) storage media require that the same information about the user data area is recorded in each ECC block of a user data area; see paragraphs [0006], [0007] and FIG. 3 of Applicants' disclosure.

In contrast to Applicants' base claims 1 and 12, Ito '032 discloses an optical disk, as shown in FIGs. 1A-1D, having nothing more than a plurality of storage layers. Information about a user data area, which the Examiner has alleged as "address information" as shown in FIG. 11, is recorded in a header of each sector. Specifically, the Examiner cites FIG. 11 of Ito '032 for disclosing an internal structure of each sector, which is a basic recording unit as described on col. 1, lines 38-39 of Ito '032, as comprising:

> "a header containing the address uniquely identifying the sector, a data block to which user data is recorded, and an error correction code (ECC) block to which is recorded a code used for error correction during reproduction."

As described in the above text and clearly shown in FIG. 11, information about a user data area of Ito '032 is recorded in a header of each basic recording unit, and **not** in at least one of an area right before and an area right after a basic recording unit of the user data area, as expressly defined in Applicants' base claims 1 and 12.

The rule under 35 U.S.C. §102 is well settled that anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference. In re Paulsen, 30 F.3d 1475, 31 USPQ2d 1671 (Fed. Cir. 1994); In re Spada, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990). Those elements must either be inherent or disclosed expressly and must be arranged as in the claim. Richardson v. Suzuki Motor Co., 868 F.2d 1226, 9 USPQ2d 1913 (Fed. Cir. 1989); Constant v. Advanced Micro-Devices, Inc., 848 F.2d 1560, 7 USPQ2d 1057 (Fed. Cir. 1988); Verdegall Bros., Inc. v. Union Oil Co., 814 F.2d 628, 2 USPQ2d 1051 (Fed. Cir. 1987). In addition, the prior art reference must be enabling. Akzo N.V. v. U.S. International Trade Commission, 808 F.2d 1471, 1479, 1 USPQ2d 1241, 1245 (Fed.

Cir. 1986), cert. denied, 482 U.S. 909 (1987). The corollary of that rule is that absence from the reference of any claimed element negates anticipation. <u>Kloster Speedsteel AB v. Crucible Inc.</u>, 793 F.2d 1565, 230 USPQ2d 81 (Fed. Cir. 1986).

The burden of establishing a basis for denying patentability of a claimed invention rests upon the Examiner. The limitations required by the claims cannot be ignored. See <u>In re Wilson</u>, 424 F.2d 1382, 165 USPQ 494 (CCPA 1970). All claim limitations, including those which are functional, must be considered. See <u>In re Oelrich</u>, 666 F.2d 578, 212 USPQ 323 (CCPA 1981). Hence, all words in a claim must be considered in deciding the patentability of that claim against the prior art. Each word in a claim must be given its proper meaning, as construed by a person skilled in the art. Where required to determine the scope of a recited term, the disclosure may be used. See <u>In re Barr</u>, 444 F.2d 588, 170 USPQ 330 (CCPA 1971).

In the present situation, Ito '032 fails to disclose and suggest key features of Applicants' base claims 1 and 12. Therefore, Applicants respectfully request that the rejection of base claims 1 and 12 and their respective dependent claims 2-11 and 13-31 be withdrawn.

Dependent claims 2-11 and 13-31 which depend from base claims 1 and 12, are deemed patentable from base claims 1 and 12 if their base claims 1 and 12 are patentable. <u>Hartness Int'l, Inc., v. Simplicatic Eng'g Co.</u>, 891 F.2d 1100, 1108, 2 USPQ2d 1826, 1831 (Fed. Cir. 1987); <u>In re Abele</u>, 684 F.2d 909, 214 USPQ 682, 689 (CCPA 1982) *see also* <u>In re Sernaker</u>, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983). Even assuming *arguendo* that independent claims 1 and 12 are not patentable under 35 U.S.C. §103, which Applicants do not believe, claims 2-11 and 13-31 are separately patentable from parent claims 1 and 12 for reasons presented herein below.

For example, dependent claims 3, 14 and 19 further define that a basic recording unit of the user data area is a physical cluster, and the information about the user data area is recorded in at least one of a run-in area and a run-out area that are right before and after the physical cluster, respectively, as shown, for example, in FIG. 11A and FIG. 11B.

In contrast to Applicants' claims 3, 14 and 19, Ito '032 illustrates, in FIG. 11, a typical data unit, which is only a sector, having a header, a data section and an ECC. There is no disclosure anywhere in Ito '032 of Applicants' claimed "basic recording unit of the user data area is a physical cluster, and the information about the user data area is recorded in at least one of a run-in area and a run-out area that are right before and after the physical cluster" as defined in claims 3, 14 and 19.

Dependent claims 4, 8, 15 and 20 further define that "the information storage medium

has at least two information storage layers," and "the information about the user data area is recorded in at least one of the area right before and the area right after the basic recording unit of the user data area in different patterns for the different information storage layers."

While Ito '032 discloses the use of multiple recording layers, there is no disclosure of any recording of " information about the user data area is recorded in at least one of the area right before and the area right after the basic recording unit of the user data area in different patterns for the different information storage layers" as defined in Applicants' claims 4, 8, 15 and 20.

Dependent claims 30 and 31 further define that "the different patterns are one of different consecutive patterns of identical intervals and different patterns of different sized intervals." Again, there is no disclosure, and there is no such inherency existing in Ito '032 of such a limitation.

Turning now to base claim 32, there is no disclosure anywhere in Ito '032 of Applicants' claimed "accessing information about the user data area, where user data is recorded, from at least one of an area right before and an area right after a basic recording unit of the user data area" and "operating the storage medium based on the accessed information" as expressly defined in base claim 32.

In view of the foregoing deficiencies of Ito '032 and these reasons, Applicants respectfully request that the rejection of claims 1-38 be withdrawn.

In view of the foregoing amendments, arguments and remarks, all claims are deemed to be allowable and this application is believed to be in condition to be passed to issue. Should any questions remain unresolved, the Examiner is requested to telephone Applicants' attorney at the Washington DC office at (202) 216-9505 ext. 232. Applicants respectfully reserve all rights to file subsequent related application(s) (including reissue applications) directed to any or all previously claimed limitations/features which have been amended or canceled, or to any or all limitations/features not yet claimed, i.e., Applicants have no intention or desire to dedicate or surrender any limitations/features of the disclosed invention to the public.

INTERVIEW:

In the interest of expediting prosecution of the present application, Applicants respectfully request that an Examiner interview be scheduled and conducted. In accordance with such interview request, Applicants respectfully request that the Examiner, after review of the present Amendment, contact the undersigned local Washington, D.C. attorney at the local Washington,

D.C. telephone number (202) 216-9505 ext. 232 for scheduling an Examiner interview, or alternatively, refrain from issuing a further action in the above-identified application as the undersigned attorneys will be telephoning the Examiner shortly after the filing date of this Amendment in order to schedule an Examiner interview. Applicants thank the Examiner in advance for such considerations. In the event that this Amendment, in and of itself, is sufficient to place the application in condition for allowance, no Examiner interview may be necessary.

To the extent necessary, Applicants petition for an extension of time under 37 CFR §1.136. If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 503333.

Respectfully submitted,

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AMENDMENTS TO THE DRAWINGS

The attached drawing(s) include changes to FIG. 8. The sheet containing FIG. 8 replaces the original sheet including FIG. 8.

In the Office Action at item3, the drawings have been objected. In order to overcome this objection, replacement figure is submitted herewith. In FIG. 8, the line through the text has been removed. Therefore, approval of these changes to the Drawings is respectfully requested.